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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Vincent M. Kane
Application No. : 10/713,608
Filed : November 14, 2003
Title : SEALED HEADER AND METHOD OF MAKING
Group/Art Unit : 2841
Examiner : Ivan H. Carpio
Docket No. : 18087

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the Final Rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

Review is requested for the reasons stated on the attached three (3) sheets.

Remarks

In an Office Action dated February 7, 2006, the Examiner rejected the independent claims, namely claims 1 and 14 as being anticipated by Pratt (US 6,652,292).

Applicant submitted a response on May 8, 2006 discussing some of the reasons why the Taguchi reference was not an anticipatory reference. The Examiner issued a Final Rejection dated July 17, 2006 and maintained the rejection of the independent claims, namely claims 1 and 14, as being anticipated by the Pratt reference.

Applicants filed a response to the Final Rejection on September 18, 2006. In an Advisory Action dated November 29, 2006, the Examiner addressed Applicant's prior arguments in paragraph 11 of the Advisory Action.

After considering the Examiner's rebuttal to Applicant's arguments, Applicant submits that a prima facie case of anticipation has not been made by the Examiner. "For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 1473, 43 U.S.P.Q.2d 1481, 1490 (Fed. Cir. 1997) (citing *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)).

Claim 1

Independent claim 1 is directed to an electronic module. Claim 1 requires, in part, "a casing defining a cavity therein, said casing having at least one opening therethrough for communication with said cavity " and "a substrate received in said cavity." The official action cites circuit board 50 of Pratt as the substrate, receptacles 20 as openings, and housing 16 as defining a cavity. Circuit board 50 sits atop and across receptacles 20 and is not within housing 16. Accordingly, the cited substrate is not received within the cited cavity. When presented with this argument, the Official Action responded that "The cavity is formed through the top of housing 16, within the cavity is a platform 54 on which circuit board 50 is located, by visual inspection of Fig. 3 we note that when the circuit board is on platform 54, it is within the cavity formed in the housing 16." Applicant respectfully disagrees with the Official Action's visual inspection of Fig. 3 of Pratt. A visual inspection of Fig. 3 fails to definitively show the height of platform 54 with respect to the outer wall of housing 16.

More importantly, claim 1 also requires that "at least one opening therethrough for

communication with said cavity." The Official Action cites receptacles 20 as the openings and state that "[t]he cavity is formed through the top of housing 16." The Official Action appears to equate the claimed openings and cavity. As claimed, the openings and the cavity are distinct pieces in communication with each other, not one that is the same piece as or a sub part of the other.

Additionally, claim 1 requires a "connector having a plurality of electrical terminals, with ... second portions extending into said cavity and into said throughholes of said substrate" and the "second portions ... [and] said substrate forming an electrical and mechanical connection therewith... wherein said mechanical connection at least partially retains said connector header and substrate to said casing." The Official Action stated "the header, terminals, and circuit board comprise a single unit connected primarily through the press fit connection of the terminals to the circuit board, therefore when the lower ends of the terminals are inserted through elements 46, 48, and 44 the terminals are aiding in the retention of the substrate (50) and header (12) to the casing (16)." As shown in Fig. 5, and acknowledged by the Official Action, the electrical and mechanical connection between the terminals and the circuit board is already present in Fig. 5. Furthermore, the substrate 50 and header 12 are coupled to each other but not to the casing 16 in Fig. 5. The mechanical coupling of the substrate 50 to the header 12 is independent of their coupling to casing 16. Removal of substrate 50 would not alter the coupling of header 12 to casing 16. Accordingly, the mechanical connection between the terminals and the substrate fails to "at least partially [retain] said connector header and substrate to said casing."

For at least the above reasons, Applicant believes that claim 1 and claims 2-13 which depend from claim 1 are believed to be in condition for allowance. Such allowance is respectfully requested.

Claim 14

Claim 14, similarly to claim 1, requires "positioning a substrate in said cavity." As discussed above, a visual inspection of Fig. 3 fails to definitively show the height of platform 54 with respect to the outer wall of housing 16. Additionally, claim 14 requires "providing a sealing member between said casing and said header which is compressed in the mating direction." The Official Action states, that element 38 is the element that reads on "the

sealing member," and that "it becomes evident that simply due to gravitational forces element 38 is compressed between the header and the casing." A reading of Pratt col. 3, ll. 41-49 shows that peripheral flange 38 is a part of header connector 12. Accordingly, flange 38 cannot be compressed between the header (of which it is a part) and the casing. Furthermore, the argument is inconsistent with statements made in the Official Action with respect to claims 9 and 20, admitting that element 38 is part of the header and with respect to claims 8 and 18, stating that the header includes a groove defined between elements 36 and 38. For at least the above reasons, Applicant believes that claim 14 and claims 15-26 that depend from claim 14 are in condition for allowance. Such allowance is respectfully requested.

Conclusion

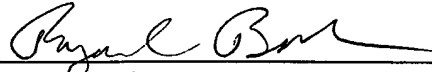
Applicants believe that that the rejection of claims 1-26 under 35 U.S.C. §102(e), **must be reversed** as the Examiner has failed to make a prima facie case of anticipation. As mentioned above, multiple limitations are missing from the Pratt reference.

Most notably, Pratt fails to teach a mechanical connection between the header and the substrate forming an electrical and mechanical connection wherein said mechanical connection at least partially retains said connector header and substrate to said casing. Additionally, Pratt fails to teach "a sealing member between said casing and said header which is compressed in the mating direction."

Application Serial No 10/713,608

Pre-Appeal Brief Request For Review Dated December 29, 2006

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 29, 2006.



D. Cwiklinski